

REMARKS

Administrative Overview

The Office action of September 1, 2005, examined claims 105-111, 113, 115-119, 121-126, 148, 150, 152-156, 159, 160, and 162-168. The Office action rejected each of these claims under 35 U.S.C. 103(a) as being unpatentable over one or more references in combination with U.S. Patent No. 5,659,384 (**Ina**).

Without acquiescing to any rejection, but in an effort to advance prosecution of the case to allowance, Applicants amend claims 105 and 152 as reflected in the Listing of Claims. No new matter is added thereby. Following entry of this amendment, claims 105-111, 113, 115-119, 121-126, 148, 150, 152-156, 159, 160, and 162-168 will be pending.

Independent claims 105 and 152 are patentable over the cited art

With regard to claim 105, the Office action does not allege that any prior art teaches or suggests the recited method of sequentially scanning a plurality of substantially non-overlapping regions of an internal biological sample, wherein the recited field stop includes a ferroelectric element and/or an electromechanical shutter.

With regard to claim 152, the Office action does not allege that any prior art teaches or suggests an apparatus for sequentially scanning a plurality of substantially non-overlapping regions of an internal biological sample, wherein the recited field stop includes a ferroelectric element and/or an electromechanical shutter.

Applicants respectfully point out that the previous Office action of March 21, 2005, stated that claims 151 and 169 (now canceled) would be allowable if rewritten in independent form. Each of these claims recited the limitation, “wherein said field stop comprises a material selected from the group consisting of a liquid crystal, a ferroelectric element, a polymer dispersed liquid crystal, and an electromechanical shutter.”

However, the Office action of September 1, 2005, appears to retract this finding, alleging the following:

Ina is just one example of many which discloses the use of a field stop which comprises a liquid crystal device (column 3, lines 32-33). It would have been obvious to one skilled in the art to have modified DeBaryshe et al such that the field stops used comprise liquid crystal devices. Such a modification merely involves the substitution of one known type of field stop for another.

Applicants traverse this rejection and respectfully note that, as stated in M.P.E.P. §2143.01, the mere fact that references can be combined does not render the resultant combination obvious

Application No. 09/841,325
Response dated December 1, 2005
Reply to Office Action of September 1, 2005

unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The Office action does not explain where in the cited references the motivation for the “substitution” allegedly appears. Therefore, Applicants respectfully contend the rejections of the claims under 35 U.S.C. 103(a) are insufficiently supported.

In the event the Examiner intends to apply a similar rejection to either or both of amended claims 105 and 152, Applicants respectfully call the Examiner’s attention to M.P.E.P. § 2144.03, which specifies that an Examiner may only take official notice of facts outside of the record which are capable of “instant and unquestionable demonstration as being ‘well known’ in the art.” In re Ahlert, 434 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970). Applicants request that any further rejection of claim 105 and/or claim 152 state the basis for the rejection, including the basis for combination of references, as specifically as possible.

Dependent claims 106-111, 113, 115-119, 121-126, 148, 150, 153-156, 159, 160, and 162-168 are patentable over the cited art

Since a dependent claim includes all the limitations of the independent claim from which it depends, Applicants respectfully request that the rejection of dependent claims 106-111, 113, 115-119, 121-126, 148, 150, 153-156, 159, 160, and 162-168 be reconsidered and withdrawn, at least for reasons described with respect to independent claims 105 and 152 as presented above.

Conclusion

In view of the foregoing, Applicants request reconsideration, withdrawal of all rejections, and allowance of claims 105-111, 113, 115-119, 121-126, 148, 150, 152-156, 159, 160, and 162-168 in due course.

If the Examiner believes that it would be helpful to discuss any aspect of the application by telephone, the undersigned representative cordially invites the Examiner to call at the telephone number given below.

Application No. 09/841,325
Response dated December 1, 2005
Reply to Office Action of September 1, 2005

Respectfully submitted,



William R. Haulbrook, Ph.D.
Attorney for Applicants
Goodwin Procter LLP
Exchange Place
Boston, Massachusetts 02109
Goodwin Customer No. 051414

Date: December 1, 2005
Reg. No. 53,002

Tel. No.: (617) 570-1013
Fax No.: (617) 523-1231

1651719v1